

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Shai Ben-Levy

Appln. No: 09/943,442

Examiner: AKINTOLA, Olabode

Filed: August 30, 2001

Art Unit: 3624

Title: ***COMPUTER TRADING OF FINANCIAL INTERESTS***

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO REQUIREMENT FOR RESTRICTION UNDER 35 U.S.C. §121

Sir:

This response is being submitted to the Official Action dated August 14, 2006, and is accompanied by a Petition for Extension of Time and fee payment.

Claims 1-41 are pending in this application. In the Office Action, restriction in this case under 35 U.S.C. §121 is required to one of eleven (11) inventions into which the Examiner has grouped the claims.

In response to the Requirement for Restriction, Applicant provisionally elects, with traverse, to prosecute the claims that correspond to Invention I (i.e., claims 1-4 and 38) from among Inventions I-XI into which the pending claims have been grouped in the Office Action, without prejudice to applicant's right to file divisional applications covering the subject matter of the non-elected claims.

According to M.P.E.P. § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be serious burden on the examiner if restriction is not required. [Emphasis added.]

The Office Action states that Inventions I-XI are related as subcombinations disclosed as usable together in a single combination, and these subcombinations are

distinct from each other because they are separately usable. (Citing MPEP §§ 806.04, 808.01).

Applicant respectfully traverses, in part, the requirement for restriction on the grounds that searching Invention I (claims 1-4, 38) and Invention II (claims 5, 39) would not be unduly burdensome and, in fact, would be necessary to ensure a complete search for a proper examination on the merits of any one of Inventions I and II. For example, claims of Inventions I and II are each directed to a method for trading financial interests that relates to receiving terms for a proposed auction in financial interests, receiving different terms relating to the financial interests of the first proposed auction, and identifying the different terms as an entry in the first proposed auction. Applicant respectfully submits that such a commonality in subject matter being searched not only indicates that it would not be unduly burdensome to search Inventions I and II as grouped in the Office Action, but also that the fields of search involved in examining Inventions I and II would, as a practical matter, be essentially co-extensive. Further, insofar as the search may not be strictly co-extensive, Applicant respectfully submits that this commonality of subject matter indicates that in searching either Invention I or Invention II (as grouped in the Office Action), the search that would apply to both Inventions I and II should be conducted in order to be sure that all pertinent art is considered for a proper examination on the merits.

Accordingly, Applicants submit that it cannot be said that to examine the claims of Inventions II in addition to the claims of Invention I would place an additional serious burden on the Examiner, as examination of the claims of Invention II would not require undue diverse searching beyond that which would be necessary for proper examination of the claims of Invention I. Moreover, as may be understood from the commonality of subject matter described above, Applicant respectfully submits that insofar as the methods for trading financial interests of Inventions 1 and II may be separably usable, they have generally similar functions, effects, and modes of operation. Thus, with respect to Inventions I and II, it is respectfully submitted that all restricted claims are properly presented in the same application, undue diverse searching would not be required, and all such claims should be examined together, which would further serve the best interests of the public.


For at least the foregoing reasons, Applicant respectfully requests that the restriction requirement be withdrawn as to Inventions I and II, and that all claims in these groups (i.e., 1-5, 38, and 39) examined on the merits.

The Examiner's consideration of this matter is gratefully acknowledged.

The Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayments to Deposit Account No. 02-4270.

Respectfully submitted,

12/14/2006
Date



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